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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/649,180

08/27/2003

Jay S. Walker

98-076-C1

5244

22927

7590

08/08/2008

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EXAMINER

PIERCE, WILLIAM M

ART UNIT

PAPER NUMBER

3711

MAIL DATE

DELIVERY MODE

08/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/649,180	Applicant(s) WALKER ET AL.	
	Examiner William M. Pierce	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 05 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-13,15-21,23-27 and 29-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-13,15-21,23-27 and 29-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/5/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

With respect to the IDS filed 5/5/08, in accordance with MPEP 609.04(a) applicant is reminded to list U.S. applications must be identified by the inventor, the eight digit application number (the two digit series code and the six digit serial number), and the filing date. If a U.S. application being listed in an IDS has been issued as a patent or has been published, the applicant should list the patent or application publication in the IDS instead of the application.

Claim Rejections - 35 USC § 112

The rejection under 112 set forth in the previous office action has not been sustained in view of applicant's remarks.

Claim Rejections - 35 USC § 102

Claims 1-3, 5-11, 13, 15-21, 23-27, and 29-43 are rejected under Section 102(e) or in the alternative under Section 103(a), for allegedly being obvious over Riendeau et al., U. S. Patent No. 6,761,633 (hereinafter "Riendeau") in view of Smith, U.S. Patent No. 5,411,260 (hereinafter "Smith"). Claim 12 was rejected under Section 103(a) in light of Riendeau and Sultan (U.S. Patent No. 6,273,817), as set forth in the previous office action and below in response to applicant's remarks.

Applicant opposes the examiners interpretation of the claims as product-by-process claims their form and language does not support his position. "A method of producing" is considered to clearly attempt to convey that one intends to "produce" a lottery ticket. Clearly steps of "causing" symbols to be "printed" such that they form a continuous path is a step that sets forth a product by how it is made. Where the construction of the claims could have been alternatively rejection under 112, for unclear scope of claim, the examiner has approached the problems with the claims under 103. Where applicant has not made attempts to amend the claim, this rejection remains.

Applicant states that the determination of patentability must be based on the recited process steps, not on an end-product. Such is not true. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). As such a prima facie case of obviousness for the claims has been established.

Riendeau inherently shows with respect to claims 1, 8 and 9, the capability to be used in accordance with a game rule associated with the lottery ticket any one of the plurality of play symbols" printed in the play area of the lottery ticket is selectable as an initial player selection. With respect to this claimed apparatus, applicant must distinguish over the prior art in terms of structure instead of function and intended use. Applicant has not met his burden of showing how Riendeau is not capable of being used where a player is capable of selecting any initial player area as an initial selection.

Likewise claim 10 is directed to a method of "creating a...lottery ticket" and is interpreted as an apparatus as set forth above with respect to claim 1. Claims 17 and 18 are clearly apparatus claims and must distinguish over the prior art in terms of structure and not rules or intended use.

With respect to independent claims 26 and 34, the selection of space 56 is considered to most broadly meet the step of where "any one of the nodes is selectable at the start of a game..." Here in Riendeau it is shown where a player has selected "any one of the nodes...at the start of the game".

Applicant argues that the alternative rational provided in the previous office action with respect to Smith is incorrect. Smith show where "any one of the plurality of play symbols...is selectable" as indicated by the travel card 14. Smith does not teach the opposite. He teaches that any node is selectable based on the corresponding indicia revealed in grid 14. This issue is clearly one of claim interpretation in view of the applied art. At its heart is that the instant claims must clearly distinguish over the applied art. Merely because applicant can offer a differing interpretation of the claims in view of the prior art to that offered by the examiner in the grounds for rejection does not overcome it. Here the examiners broad interpretation of the claims in view of the applied art is considered reasonable and remains.

Applicant reassert that Riendeau does not teach that any one of the plurality of play symbols or nodes in the play area of a ticket is selectable by a player as an initial player selection but fails to meet his burden to show where the prior art is not capable of functioning as recited in his claims. Here applicant has not shown where the applied prior art is not capable of being used in this way. Merely changing the rules of play surrounding the use of an apparatus do not change its physical structure. Where applicant believes that Riendeau specifically teaches that a player must make a first selection at the start of the game from one of the designated "nodes". This is only based upon how Riendeau intends to play his game. Nothing in the structure of the lottery game of Riendeau prevents playing his game or changing the rules of play as functionally recited in the apparatus claims currently recited. A player clearly can just select any one of the depicted "nodes" or points in the play area at the start of the game if they desire to do so.

With respect to Claims 2 and 11, the claims must distinguish over the art in terms of structure and not "functionality" or such printed symbols, and neither does Smith. Examiner offers a board interpretation of how the language of the claims reads on the applied art. There is no error in interpreting the "negative symbols" of Riendeau cause the paths to be considered "non-continuous" where a continuous path may be considered to be one of all positive nodes.

Claim Rejections - 35 USC § 103

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Riendeau in view of Sultan 6,273,817 as set forth in the previous office action.

Conclusion

Applicant's arguments filed 5/5/08 have been fully considered but they are not persuasive as set forth above in the grounds for rejection.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Pierce whose telephone number is 571-272-4414 and E-mail address is bill.pierce@USPTO.gov. The examiner can normally be reached on Monday and Friday 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, communication via email at the above address may be found more effective. Where current PTO internet usage policy does not permit an examiner to initiate communication via email, such are at the discretion of the applicant. However, without a written authorization by applicant in place, the USPTO will not respond via Internet e-mail to any Internet correspondence which contains information subject to the confidentiality requirement as set forth in 35 U.S.C. 122. A paper copy of such correspondence will be placed in the

appropriate patent application. The following is a sample authorization form which may be used by applicant:

"Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with me by responding to this inquiry by electronic mail. I understand that a copy of these communications will be made of record in the application file."

For further assistance examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/William M Pierce/

Primary Examiner, Art Unit 3711